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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/626,596

07/25/2003

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EXAMINER

VIANA DI PRISCO, GERMAN

ART UNIT

PAPER NUMBER

2616

MAIL DATE

DELIVERY MODE

05/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/626,596

Applicant(s)

SHEN ET AL.

Examiner

German Viana Di Prisco

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/25/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### ***Information Disclosure Statement***

2. The information disclosure statements submitted on 07/25/2003 have been considered by the Examiner and made of record in the application file.

### ***Drawings***

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory matter. A computer program per se is not patent eligible subject matter. The computer program product claimed is not combined with an appropriate computer readable medium capable of producing a useful, concrete and tangible result when used in a computer system. Therefore said computer program product does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Rao et al. (United States Patent Application Publication No.: US 2003/0219103 A1).

Consider claims 1-3 Rao et al. clearly show and disclose a lawful interception device including an SIP (Session Initiation Protocol) proxy server (figure 7 and paragraph [0079]) and an MGC (Media Gateway Controller) (figure 5 and paragraph

[0019]) to detect information in the signaling information being transmitted between two IP (Internet Protocol) parties and to generate instructions out of the detected signaling information for instructing an RTP (Real-time Transport Protocol) proxy server to create channels to bypass a media stream to be intercepted via an intermediate storage medium (paragraph [0079]).

7. Claims 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Takeda et al. (United States Patent Application Publication No.: US 2003/0110292 A1).

Consider claim 4, Takeda et al. clearly show and disclose a method for performing SIP signaling for a media stream (figure 1 and paragraphs [0018]-[0021]), including the following steps: receiving an SIP invite message of a first IP party (paragraph [008]), adapting at least one connection parameter in the SDP (Session Description Protocol) of the received SIP invite message, transmitting the adapted SIP invite message to a second IP party, receiving an SIP response message of the second IP party, adapting at least one connection parameter in the SDP (Session Description Protocol) of the received SIP response message, transmitting the adapted SIP response message to the first IP party (figures 8-15 and 23 and paragraphs [0022]-[0025]).

Consider claim 5, and as applied to claim 4 above, Takeda et al. clearly show and disclose a method for performing SIP signaling for a media stream wherein at least

one connection parameter includes information about a bypass channel, an address, or a port (figures 8-15 and paragraph [0092]).

Consider claim 6, and as applied to claim 4 above, Takeda et al. clearly show and disclose a method for performing SIP signaling for a media stream wherein the connection parameters sent to both IP parties differ from each other (different port numbers as shown in figures 8-15).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Mohaban et al. (United States Patent No.: 7,209,473 B1) disclose a method and apparatus for monitoring and processing voice over internet protocol packets including lawful interception. Uusitalo et al. (United States Patent Application Publication No.: US 2005/0063544 A1) disclose a method of lawful interception of an IP packet between two or more terminals.

9. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to German Viana Di Prisco whose telephone number is (571) 270-1781. The examiner can normally be reached on Monday through Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/626,596

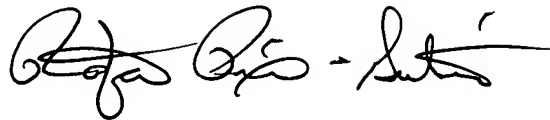
Page 7

Art Unit: 2616

German Viana Di Prisco

G.V.D.P./gvdp

May 25, 2007

A handwritten signature in black ink, appearing to read 'Rafael Pérez-Gutiérrez'.

RAFAEL PÉREZ - GUTIERREZ  
SUPERVISORY PARENT EXAMINER